



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,187	03/08/2001	Kazuyuki Yokokawa	67134-5071	4101

24574 7590 10/12/2006

JEFFER, MANGELS, BUTLER & MARMARO, LLP
1900 AVENUE OF THE STARS, 7TH FLOOR
LOS ANGELES, CA 90067

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/801,187	Applicant(s) YOKOKAWA, KAZUYUKI	
	Examiner Nasser Ahmad	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 181-264 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 181-264 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/12/06, 6/20/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejection Withdrawn

1. Claim 207 rejected under 35 U.S.C. 112, second paragraph, made in the last Office Action of 2/9/2006 has been withdrawn in view of the amendment filed on 7/12/2006

Rejections Maintained

2. Claims 181-222 (typographical error has been corrected) are rejected under 35 U.S.C. 102(e) as being anticipated by Mihara (6380132) for reasons of record made in the last Office Action of 2/9/2006.
3. Claim 187 is rejected under 35 U.S.C. 112, second paragraph, for reasons of record made in the last Office Action.

Response to Arguments

4. Applicant's arguments filed 7/12/2006 have been fully considered but they are not persuasive.

In response to the "adapted to cause" language, applicant is directed to MPEP 2111.04. the invention as claimed, for example in claim 181, the language "adapted to cause" does not limit the scope of the claim nor does it limit the claim to a particular structure. As mentioned in the last Office action, paragraph-5, said phrase is not found to be of positive limitation and hence, have not been given any patentable weight. To further explain, the phrase "adapted to cause" does not distinguish the product structure as claimed because it is directed to a step to be performed in the future as evidenced by

Art Unit: 1772

the phrase "when the sheet structure ...is bent...downwardly only once", which is found to be an intended future use of the claimed structure.

Regarding the argument made by the applicant for rejection of said "adapted to cause" phrase, the above explanation also apply herein.

Further, in response to applicant's argument #2 (page-15 of the amendment), the same phrases have been repeated numerous times in the claims. For example, claim 181 repeats multiple times the phrase "when the sheet structure or a portion thereof is bent"; in claim 182 the phrase "are printable"; claim 190 has the phrase "adapted to"; in claim 200, the phrase is "can be bent...sheet portions"; claim 202 has "are printable"; claim 205 has "when separated from the sheet"; claim 209 has "adapted to"; etc.

For item#3, the intended use phrase, as reasoned in the last Office Action, para-5, is not directed to a positive limitation to the claimed structure but is directed to a future use of the claimed structure.

Responding to #4 (amendment, page-15), applicant is directed to hereinabove and also to the last Office Action for explanation regarding the "adapted to" and the intended use phrases. These phrases have been considered but does provide a positive limitation to the claimed structure.

For #5, examiner disagrees with the applicant as to the intended use or "adapted to cause" phrases which are not found to be of positive limitations.

For #6, Applicant has merely argued the phrases "adapted to cause", etc. applicant is informed that as explained hereinabove said phrase are not found to be of positive limitations.

Art Unit: 1772

Responding to item #7, applicant is again arguing the non-positive phrases of the claim which has been addressed before.

Regarding the 35 USC 112, second paragraph rejection, claim 181 states that **the first and second cut lines being parallel to each other; that the third and fourth cut lines being parallel to each other and perpendicular to the first and second cut lines and intersecting them**. While claim 187 recites that **a perimeter edge of the sheet forms a portion of a perimeter of at least one of the sheet portions**. Thus, it is not clear as to how can a perimeter edge form a perimeter portion of the sheet portion when is bound by four cut lines.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or found to be indefinite for reasons discussed above.

The following are new ground of rejection for the newly submitted claims 223-264:

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1772

6. Claims 223-264 are rejected under 35 U.S.C. 102(e) as being anticipated by Mihara (6380132).

Mihara relates to a multilayered sheet structure (1) comprising a first layer (7) and a second layer (5). Figure-8 shows four continuous cut lines (2) that intersect to form a rectangular shape with opposite parallel cut line pairs being perpendicular to each other. The cut lines cut completely through the first layer (figure-9) but not entirely through the thickness of the multilayered sheet (figure-2).

Figure-8 shows the presence of an image on the sheet.

Figure-5 shows the cut line configured by their depth, groove width and shape.

Figure-5 also shows an adhesive layer (6) between the first layer and the second layer.

The release liner (5) can be of paper such as poly-laminated paper (col. 6, lines 11-13).

The perimeter edge of the sheet forms a portion of one sheet portions (figure-1D).

The sheet is photo-receptive (8).

The first layer can be a film and the second layer can be a poly-laminated paper (col. 7, lines 49-52).

The cut lines are die-cut lines (3).

The second layer can a resin film (col. 6, lines 11-13).

A fifth cut line is provided as the cut line for the second cut portion as shown in figure-8.

The phrases "capable of causing" (claims 223, 242), "adapted to" (claims 232, 251)

have not been given any patentable weight because said phrases are not found to be of positive limitation as it only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Art Unit: 1772

The intended use phrases such as “when the sheet structure or a portion thereof is bent” (claim 223), “are printable” (claim 224, 244), “when bent...individual sheet portions” (claim 242)”, “when separated” (claim 247), etc. have not been given patentable weight because said phrases are not deemed to be of positive limitations.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

Art Unit: 1772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Nasser Ahmad 10/2/06
Primary Examiner
Art Unit 1772

N. Ahmad.
October 2, 2006.